

REMARKS

The Amendments

The claims are amended to make non-substantive clarifications, including addressing the claim objection, and to add a further dependent claim. The amendments do not narrow the scope of the broadest scope of the claims. Claims 1-18 are now pending herein.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Claim Objection

The objection to claims 8-10 and 12-17 for being in improper multiple dependent form is believed to be rendered moot by the amendment to claim 8.

The Provisional Obviousness-type Double Patenting Rejection over U.S. Application Nos. 10/625,129

The provisional obviousness-type double patenting rejection of claims 1-7 over claims 1, 2 and 4-6 of copending Application No. 10/625,129 is respectfully traversed.

Applicants respectfully submit that the instantly claimed invention is not an obvious variant of the claimed invention of the copending application. Applicants' invention (of claim 1) is directed to a combination of a compound of formula 1 with a compound of the formula 2. While the compound of applicants' formula 2 is a betamimetic, it is a particular betamimetic. The claims of the copending application require a compound of formula 1, a corticosteroid and a betamimetic -- generally. There are no claims in the copending application which require or suggest the particular betamimetic of applicants' formula 2. To the contrary, claims 9 and 10 of the copending application directed to particular betamimetics do not include the compound of applicants' formula 2. Further, one of ordinary skill in the art reading the specification of the copending application would not be directed to select a composition comprising a betamimetic of applicants' formula 2. The copending application's disclosure provides a list of exemplary betamimetics but none of these are a compound of the formula 2 or suggestive of a compound of the formula 2. Applicants' invention lies, in part, in the combination of the particular betamimetic of formula 2 in the compositions. As stated in the instant specification (page 2, line 20, to page 3, line 3):

Surprisingly, an unexpectedly beneficial therapeutic effect, particularly a synergistic effect, can be observed in the treatment of inflammatory or obstructive diseases of the respiratory tract if the anticholinergic of formula 1 is administered together with the compound of formula 2. In view of this synergistic effect, the drug combinations according to the invention can be used in smaller doses than would be the case with the individual compounds used in monotherapy in the usual way. As another positive aspect of the present invention, this reduces unwanted side effects such as may occur when betamimetics are administered, for example. Unwanted side effects which deserve special mention in this context are the stimulant effects on the heart which may be caused by betamimetics, particularly tachycardia, a stronger heartbeat, pain resembling angina pectoris, as well as arrhythmia.

Neither the combination of the particular betamimetic of applicants' formula 2, nor the advantage thereof, is suggested to one of ordinary skill in the art from the claims (or disclosure) of the copending application. Thus, the instant claims are not an obvious variant

of any claim of the copending application.

The instant claims are further shown to not be obvious variants of the claims of the copending application because all the claims of the copending application require a composition containing a corticosteroid. Although, as pointed out in the Office Action, the instant claims (except claim 11 and new claim 18) do not exclude a corticosteroid, an invention defined by claims requiring a corticosteroid is distinct from an invention which does not require a corticosteroid. The invention of the copending application lies in part on the inclusion of the corticosteroid. That the instant claims do not require a corticosteroid for patentability shows that the invention thereof is otherwise distinct. The incidental fact that there is potential for overlap between the two claims, due to the "comprising" language of the instant claims, does not support an obviousness-type double patenting rejection. If this were true, every chemical composition claim using "comprising" language would be subject to obviousness-type double patenting over every commonly owned application directed to some other chemical compound or composition since the claimed chemical composition could potentially contain any of the other such chemicals or compositions.

Both of the above reasons, independently and certainly when taken together, demonstrate that the instant claims are not an obvious variant of the claims of the copending application. The facts do not support that applicants are seeking two patents on the same invention or a substantially similar invention. As discussed, the patentability of the claims of the two applications are based on distinct aspects. Thus, the provisional obviousness-type double patenting rejection should be withdrawn.

It is further noted that this is a provisional rejection and that both applications are currently in prosecution and subject to rejections. Taking positive action would be premature at this point as one or both applications could be amended during their respective ongoing

prosecutions in a way which would render this provisional rejection moot. Thus, positive action – which in view of the above remarks is not deemed necessary – will be deferred until such time as may be appropriate.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

Respectfully submitted,

/wendy petka/

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